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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,354	03/12/2004	Michio Nakayama	H6810.0071/P071-B	5603
24998	7590	05/20/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			PALABRICA, RICARDO J	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	
			3641	
DATE MAILED: 05/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,354

Applicant(s)

NAKAYAMA ET AL.

Examiner

Rick Palabrica

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's 4/4/05 Amendment, which amended claims 13-15 and traversed the rejection claims in the 11/4/04 Office Action is acknowledged.

Response to Arguments

2. Applicant's arguments filed with said Amendment have been fully considered but they are not persuasive for the reasons given below.

First, the claims are directed to a product (a control rod) and the invention is defined in terms of product-by-process claims. Applicant's arguments, on the other hand, are based on a showing that his process of making the control rod is different from the process of the prior art. As stated in the 11/4/04 Office Action, if the product is the same or obvious from a product of the prior art, the claim is unpatentable even though a different process made the prior product. Applicant has not shown that his product is different from the product of the prior art. For example, the Applicant argues that his invention is different from the prior art because the welding attachment of the sheath to the tie rod is performed indirectly, i.e., by heating the tie rod and the resulting heat is transferred to the sheath. He argues that Yamada et al. performs the same sheath-to-tie rod attachment directly, i.e., irradiating the sheath to cause its attachment to the tie rod. The difference cited by the Applicant pertains to the process of attachment. Applicant's product is the same as Yamada et al.'s product, i.e., a sheath attached to a tie rod.

Second, Applicant also argues that Yamada et al. "creates problems in the manufacturing process". (Again the Applicant is focusing here on problems with process instead of problems with the product). He asserts that if Yamada et al. commits an error in positioning the laser beam, the sheath is heated to melt down to cause welding failure. This statement implies that if Yamada et al. do not commit a laser positioning error, then the prior art process yields the same product as Applicant's claims. It is inherent that not all of Yamada et al.'s operation result in a welding error and those that are error free yield products that read on Applicant's claims.

Third, the Examiner has shown in the 11/4/04 Office Action how the prior art discloses or reads on the elements of Applicant's claimed product. Applicant has not shown that the references neither teach what the Examiner has stated they teach, nor that the Examiner's reasoning for and manner of combining the references is improper or invalid.

Fourth, Applicant's amendment that adds the process limitation, "not irradiating directly on the sheath" does not overcome the rejections based on prior art, for the same reason given above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al. (JP 2000-329885).

The reasons are the same as those stated in section 2 of the 11/4/04 Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawashima et al. (U.S. 6,028,906) in view of Yamada et al. (U.S. 6,647,082).

The reasons are the same as those stated in section 3 of the 11/4/04 Office Action.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 571-272-6880. The examiner can normally be reached on 6:30-5:00, Mon-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RJP
May12, 2005


MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER